REMARKS

This amendment is filed in response to the Final Office Action dated April 25, 2005. This amendment is filed with a Request for Extension of Time, and a Request for Continued Examination. Claims 1-22 are pending in the present application. By this amendment, claims 1-15, 17, and 19-22 have been amended. Applicants respectfully request consideration of the present application in view of the foregoing amendments and the following remarks. No new matter has been added.

Support for Claim Amendments

Support for independent claims 1, 13, 21 & 22 can be found throughout the specification. In particular, the specification teaches embodiments where the pool of test takers, from which candidates for the claimed process for admissions are identified, includes students who did not initially apply to the particular academic institution. *See, e.g.,* Application p. 12, ln. 15-18. The specification also teach the use of a computer program product that enables implementation of the methods described in the specification. *See, e.g.,* Application p. 17, ln. 28 – p. 18, ln. 6. Regarding the remaining amendments, they are minor adjustments, such as, insuring that the claim language is consistent with the claims on which they depend. Accordingly, no new matter is introduced by the current claim amendments.

Claim Rejections Under 35 U.S.C. §112, first paragraph

In the Office Action, claims 3, 12, and 15 were rejected under 35 U.S.C. §112, first paragraph. The rejection states that the claims failed to provide an adequate description of calibrated grading and how to determine what levels the individual or multiple tests are separated into. Affidavits explaining the calibrated grading process are attached. This rejection is overcome.

There are two primary methods of evaluating examinations using a calibrated process. In the first method, test takers are assigned a particular score that is indicative of their mastery of the subject matter covered by the exam. In the second, a test administrator can determine what percentile each test taker falls into by ranking the test takers' scores from highest to lowest then dividing their ranking by the total number of test takers. The specification describes both the use

of a pre-determined score, *see, e.g.,* Application, p. 17 ln. 8-11, and the use of a percentile, *see, e.g.,* Application, p. 16, ln. 8-11, as means of determining which enrolled test takers should be offered admission to the particular academic institution.

The process of calibrated grading, as set forth in the Application, is described in sufficient manner as to enable one of ordinary skill in the art to use the present invention. *See, e.g.,* Application p. 16, ln. 1-25 and Figure 5. The phrase "calibrated grading" is well known among those of ordinary skill in the art of administering and grading examinations, such as written examinations, that require more than one grader to subjectively assess exams from a group of test takers. *See* Affidavits of Jean C. Gaskill and Stephen P. Klein. As used in this context, calibrated grading is a process used to insure that each grader evaluating a set of exams assign a particular exam approximately the same rating or score. In other words, the calibration process is implemented to prevent the score or ranking a test taker receives for their examination from being a function of which evaluator assessed the test taker's examination. The process typically relies on a lead grader, or trainer, who meets with all of the graders before grading commences. At the meeting, the graders discuss how the exams should be evaluated and how points should be awarded for addressing specific issues in a variety of ways. For a detailed discussion, *see* "A Model for Grading Bar Examination Essay Questions" by Jean Gaskill. The term "calibrated grading" is adequately described in the specification. *See, e.g.,* Application p. 16, ln. 1-25 and Figure 5. In addition, the accompanying Affidavits demonstrate that the term "calibrated grading" alone would allow a person of ordinary skill in the art to implement a successful calibrated grading process without undue experimentation. *See* Affidavits of Jean C. Gaskill and Stephen P. Klein. Clearly, the term is adequately described in accordance with accepted U.S. patent law based upon the Applicant's description of the process in the Application and the knowledge of those skilled in the art. Accordingly, Applicant respectfully requests withdrawal of this rejection.

Claim Rejections Under 35 U.S.C. §101

Claims 1-21 were rejected under 35 U.S.C. §101 for an asserted lack of utility. The Applicant has amended independent claims 1, 13 & 21 to recite that the "identifying step is enabled by a computer product." The amendments combined with the Affidavit of Philip D.

Shelton clearly establishes that technology is an important part of the claims and that technology advances the processes described therein. The Applicant respectfully submits that the amended claims satisfy the utility requirements of 35 U.S.C. §101.

Claim 1 now recites a method for a first academic institution to admit test takers who have applied for admission to at least one second academic institution. The method of Claim 1 includes the selection of a pool of standardized test takers that includes some test takers who did not initially apply for admission to the first academic institution. From this pool, the method uses a computer product to identify the test takers who have applied for admission to at least one second academic institution, but have not received an offer for admission to any of the second academic institutions to which they applied. The first academic institution provides an abbreviated academic program as an alternative admissions process. The test takers that enroll in the alternative admissions program are subjected to one or more scored examinations during the abbreviated academic program. Finally, the first academic institution admits those test takers who achieve a score on the exam, or exams, that satisfies an admissions criteria. Similar "computer product" recitations have been included in independent claims 13 & 21. Accordingly, claims 13 & 21 are also patentable as set forth above, and because of the additional features recited therein.

The use of a computer product, e.g. a computer or computer software, is explicitly incorporated into the body of Claim 1. Since Claims 1, 13 & 21 all require searching through a pool of test takers that includes a number of test takers that did not apply to the particular academic institution, the number of test takers involved in the identifying step can be large. A typical pool might include a few hundred test takers, a few hundred thousand test takers, or more.[1] In light of the amendments and sworn statements from Philip D. Shelton's Affidavit, the recitation of a computer product (i.e. technology) cannot be characterized as a mere nominal use. Rather, the use of a computer product is a necessary and enabling aspect of the methods recited in the current claims.[2] Clearly, the use of a computer product to identify, from a large pool of

[1] In the 2004-2005 testing year there were 143,310 LSAT test takers (See appendix B). In the 2003-2004 testing year, there were 1,419,007 SAT test takers (See appendix B).

[2] This is illustrated by considering how long it would take to manually identify students according to the independent claims. For simplicity, it is assumed to take 30 seconds to review the credentials of a single test taker from the pool and determine whether that test taker meets the identification requirements for any given claim. For

test takers, those test takers who were not admitted to any academic institution is a use that advances the inventive method. Accordingly, the Applicant respectfully submits that Applicant's present claims satisfy the statutory utility requirements set forth in 35 U.S.C. §101.

Claim Rejections Under 35 U.S.C. §102(b)

Claims 1, 13 and 20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by www.gradcollege.swt.edu (hereafter "Grad College"). The Applicant respectfully submits that the prior art does not teach the method of the amended claims.

Grad College is directed to the well known practice of conditionally admitting students *who have applied to a university*. The students selected for conditional admission in Grad College are those who were close to meeting the standardized test and G.P.A. guidelines used for admission to the university, i.e. they had "borderline credentials." Alternately, the conditionally admitted students may have met one of the admission requirements, but not others.

As amended Claims 1, 13, and 20 all recite that the pool from which test takers who participate in the program for admissions are chosen, includes test takers that *did not initially apply to that particular academic institution*. Unlike Grad College, or any other conditional admissions program the Applicant is aware of, *see* Affidavit of Philip D. Shelton, the method of the present invention can enable a student that *never filed a formal application* to a particular academic institution to gain admission to that academic institution. See, e.g. Application, p. 12, ln. 15-18. Clearly, this element is not taught by Grad College. Accordingly, the Applicant submits that these amended claims present allowable subject matter.

Another distinction between the conditional admissions programs cited in the Office Action and the present claims, is that the present claims can result in the admission of test takers with less than borderline credentials. By identifying those students who were not accepted by any academic institutions, the test takers that are offered a spot in the program for admissions are typically those having poor standardized test scores and G.P.A.s. It is common that the test takers identified by the identification step have such low test scores and G.P.A.s that they would

---

the 2004-05 LSAT, such a review could be completed by a single person working continuously for approximately 50 days [49.8 days= (143,310*0.5 minutes/application)/60 minutes an hour/24 hours a day]. For the 2003-04 SAT,

not have borderline credentials for any academic institutions to which they applied. This aspect of the present claims is so atypical that Philip D. Shelton, CEO of the Law School Admissions Counsel, the body that administers the LSAT, *has not heard of any school requesting a similar search*. *See* Affidavit of Phillip Shelton. Clearly, this element is not taught by Grad College. Accordingly, the Applicant submits that these amended claims present allowable subject matter.

For at least the reasons given above, Applicant respectfully submits that claims 1, 13, and 20 are allowable over the prior art of record.

Claim Rejections Under 35 U.S.C. §103 (a)

A prima facie case of obviousness requires (1) a motivation or suggestion to combine the teachings of the references, (2) a reasonable expectation of success, and (3) that the prior art references *must teach or suggest all the claim limitations*. *See* MPEP §2143. An obviousness rejection cannot be sustained if any of these elements is not established or the applicant can rebut any of the elements. As discussed above, Grad College does not teach (1) offering an admissions program to students who did not initially apply to the institution or (2) offering an admissions program to students who did not submit credentials that were, at least, borderline. In fact, none of the cited art teaches or suggests either of these elements of the present claims. Claims 2-12 & 14-19, which depend on claims 1 & 13, present patentable subject matter as set forth above and because of features recited therein. The Applicant asserts that since claims 21 & 22 contain both elements set forth above and additional features, these claims also present patentable subject matter.

Secondary considerations, such as the failure of others and long-felt but unresolved needs, are considered as indicia of nonobviousness. *See* MPEP §716.01(a). Philip D. Shelton, President of the LSAC, the group that administers the LSAT, states that the LSAT is the best standardized admission test in the admission testing industry. *See* Affidavit of Philip D. Shelton. The score a test taker achieves on the LSAT, while representing a bell curve centered on that value, is indicative of the most likely level of performance. Thus, like all bell curves, a significant percentage will perform better than mode, i.e. the score the test taker received. As

---

the same review would take more than one year and four months [492.7 days= (1,419,007*0.5

acknowledged by Mr. Shelton, even after extensive research, the LSAC has been unable to identify a single variable or combination of variables that will identify test takers who will significantly outperform test takers with much higher scores. *See* Affidavit of Philip D. Shelton.

Clearly, a method to identify these high-performing, low-scoring test takers is a long-felt but unmet need in the field of law school admissions. The program incorporating the claimed methods has achieved commercial success and has been licensed to other academic institutions, evidencing that the claimed methods fulfill this long-felt need. An affidavit evidencing the commercial success was filed in response to the previous Office Action. Equally clearly, others have attempted unsuccessfully to address this need. The claimed methods successfully addresses this long-felt, but unmet need. *See* Affidavit of Philip D. Shelton. Both of these secondary factors argue strongly against obviousness in the present case. *See* MPEP §716.04. Accordingly, the Applicant respectfully submits that the combinations suggested in the Office Action are not obvious.

As noted above, the LSAT is the best standardized admissions test in the industry. Thus, if the LSAT cannot identify these high-performing, low-scoring test takers, neither can the MCAT, DAT, VCAT, PCAT, AHPAT, GRE, or the GMAT. In fact, the need for the method of the present claims would be even greater for these other admissions tests. Accordingly, it is respectfully submitted that the combinations suggested in the Office Action are not obvious.

For at least the reasons given above, Applicants respectfully submit that all claims in the present Application present patentable subject matter.

Claim 22 stands rejected under 35 U.S.C. §103 (a) as being unpatentable over Grad College in view of U.S. Patent No. 6,088,686 to Walker et al. (hereafter "Walker"). This rejection is respectfully traversed.

As with Grad College, Walker does not teach or suggest that a particular academic institution's program for admissions consider admitting a test taker who is a non-applicant or who, according to the test taker's G.P.A. and standardized test scores, has less than borderline credentials for a particular academic institution. Rather, Walker is directed to an on-line application process for identifying individuals who have applied to a particular institution that

---

minutes/application)/60 minutes an hour/24 hours a day].

are *well qualified* according to the information provided along with the application. Clearly, Walker does not teach or suggest a program for admissions that admits non-applicants. Furthermore, Walker does not teach or suggest admitting individuals whose application information indicates they are poorly suited for admission. Accordingly, since the combination of Grad College and Walker fails to teach or suggest each element of the Applicant's claimed invention, a prima facie case of obviousness can not be made with the cited art. *See* MPEP §2143.

As set forth above, none of the pending claims are taught or suggested by the cited art. Accordingly, the Applicant respectfully submits that all pending claims are in condition for allowance.

Conclusion

For at least the reasons given above, Applicant submits that claims 1-22 define patentable subject matter and are in condition for allowance. Accordingly, Applicant respectfully requests allowance of these claims. The foregoing is submitted as a full and complete Response to the Office Action mailed April 25, 2005, and early and favorable consideration of the claims is requested. Should the Examiner believe that anything further is necessary in order to place the application in better condition for allowance, the Examiner is respectfully requested to contact Applicant's representative at the telephone number listed below. Applicants provides herewith a fee in the amount of $60.00 to cover the cost of a one-month time extension. No additional fees are believed due; however, the Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, to Deposit Account No. 50-0951.

Respectfully submitted,

Date: 8/24/05

J. Rodman Steele, Jr.
Registration No. 25,931
AKERMAN SENTERFITT
Post Office Box 3188
West Palm Beach, FL 33402-3188
Telephone: (561) 653-5000